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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/731,606	12/08/2003	Yuko Takeda	60395 (49381)	4761
21874 7590 12/19/2008 EDWARDS ANGELL PALMER & DODGE LLP P.O. BOX 55874 BOSTON, MA 02205				
EXAMINER				
TRAORE, FATOUMATA				
ART UNIT		PAPER NUMBER		
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Advisory Action  
Before the Filing of an Appeal Brief**

<b>Application No.</b> 10/731,606	<b>Applicant(s)</b> TAKEDA ET AL.
<b>Examiner</b> FATOUmata TRAORE	<b>Art Unit</b> 2436

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 09 December 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.  
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.  
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: 1-19.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_.  
13. ☐ Other: \_\_\_\_\_.

/Nasser G Moazzami/  
Supervisory Patent Examiner, Art Unit 2436

Continuation of 11, does NOT place the application in condition for allowance because: Applicant argued that "Imai fails to teach or suggest a sheet, on which the encrypted image is formed, having one or a plurality of memories in which the encryption key is written. Thus, Imai fails to teach or suggest, for example, at least the following elements of claim 1:

- i. an image forming apparatus including an acquisition unit for acquiring an image signal, and an image forming unit for forming an image based on the image signal acquired by said acquisition unit on a sheet having one or a plurality of memories;
- ii. a writing unit for writing the encryption key into the memory on said sheet having one or a plurality of memories; and
- iii. said image forming unit forms an image based on the image signal encrypted by said encrypting unit on said sheet having one or a plurality of memories"

The examiner submits as disclosed by the previous office action, the examiner relied on Monroe et al to disclose such feature see (column 1, lines 50-60; column 2, lines 25-35; column 4, lines 32-40).

Regarding Imai failing to disclose:

an image forming apparatus including an acquisition unit for acquiring an image signal, and an image forming unit for forming an image based on the image signal acquired by said acquisition unit on a sheet having one or a plurality of memories  
The examiner respectfully disagrees and submits that Monroe et al discloses: an image forming apparatus including an acquisition unit for acquiring an image signal (the step of acquiring personal video information for a user of an identification card) (see column 1, lines 50-60; column 2, lines 25-33), and an image forming unit for forming an image based on the image signal acquired by said acquisition unit on a sheet having one or a plurality of memories (column 2, lines 25-33; Fig. 2, item 36);

Regarding Imai failing to disclose:

- ii. a writing unit for writing the encryption key into the memory on said sheet having one or a plurality of memories; and
- iii. said image forming unit forms an image based on the image signal encrypted by said encrypting unit on said sheet having one or a plurality of memories"

The examiner respectfully disagrees and submits that Monroe et al discloses:

- ii. a writing unit for writing the encryption key into the memory on said sheet having one or a plurality of memories (digitizing the acquired video information for storage in card's memory means) (column 1, lines 50-60); and
- iii. said image forming unit forms an image based on the image signal encrypted by said encrypting unit on said sheet having one or a plurality of memories (column 4, lines 59-65)"

Applicant also argued that "Monroe fails to make up for the deficiencies of Imai. As discussed at the cited portion, Monroe discloses a "smart card," which "comprises a plate 32 including a magnetic stripe 34 for magnetically storing data and an integrated circuit," which comprises an EEPROM memory chip with a microprocessor." The card serves as "a memory storage device for storing fake-proof video information data for later retrieval."

Monroe fails to teach or suggest at least the following:

- (i) an encryption key creating unit for creating an encryption key when said acquisition unit acquires an image signal;
- (ii) an encrypting unit for encrypting the image signal with the encryption key created by said encryption key creating unit;
- (iii) a writing unit for writing the encryption key into the memory on said sheet having one or a plurality of memories; and
- (iv) said image forming unit forms an image based on the image signal encrypted by said encrypting unit on said sheet having one or a plurality of memories"

The examiner respectfully disagrees and submits that the combined teaching of Imai and Monroe et al discloses every feature of claim 1 as discussed above.

Applicant also argued that "Monroe does not disclose or suggest writing an encryption key into a memory on a sheet, as described in claim 1 of the present application"

The examiner respectfully disagrees and submits that Monroe et al discloses writing an encryption key into a memory on a sheet (column 1, lines 50-60);

Applicant argued that "Imai does not disclose or suggest "writing an encryption key into a memory on a sheet" of claim 1"

The examiner respectfully disagrees and submits that in addition of Monroe et al disclosure of such feature, Imai also discloses writing an encryption key into a memory on a sheet (see column 3, lines 22-33).

Therefore, the examiner the examiner submits that the combined teaching of Imai in view of Monroe et al discloses such feature.

Regarding claim 2, the examiner maintains the rejection based on the same rational as applied to claim 1 above, and therefore maintains the rejection.

Regarding claim 3, the examiner maintains the rejection based on the same rational as applied to claim 1 above, and therefore maintains the rejection.

Regarding claims 5-11 and 14-20, the examiner maintains the rejection based on the same rational as applied to claim 1 above, and therefore maintains the rejection.

Regarding claims 7 and 16, applicant argued "It is not seen where the cited combination discloses that the image forming unit forms the number of times (the decrypted image is formed on a sheet) in a visually inconspicuous form within a region where the image is formed, as claimed herein"

The examiner respectfully disagrees and submits that Harada et al discloses that said image forming unit forms the number in a visually inconspicuous form within a region where the image is formed (the condition storage unit shows a permitted playback number of time) (paragraph [0024], [0214]-[0240]).

Regarding claims 10 and 19, Applicant argued "Further with respect to claims 10 and 19, it is not seen where the combination of Imai, Monroe and Harada disclose an apparatus wherein the information read by said memory reading unit includes one or a plurality of identifiers of image forming apparatus, as claimed herein. There is not even a hint of a suggestion for storing an identifier of the image forming unit in the cited prior art combination".

The examiner respectfully disagrees and submits that Harada et al discloses that he information read by said memory reading unit includes

one or a plurality of identifiers of image forming apparatus(see paragraph [0025] the identifier been permitted playback number of times, permitted playback period etc.).

Regarding claims 11 and 20, Applicant argued that "Also, with respect to claims 11 and 20, it is not seen where the combination of Imai, Monroe and Harada et al disclose an apparatus wherein the memory reading unit includes a code and an input code is compared with the code in memory to determine whether to decrypt the image signal. The Examiner refers to permissive conditions set forth in Harada for making the decrypted image, however, those conditions fail to include a code. They merely refer to permissive numbers of copies or permissive periods for making copies and the like"

The examiner respectfully disagrees and submits that Harada et al discloses such feature (see paragraphs [0306]-[0310])..